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Maryam Bani Jamali
Schlumberger Technology Corporation
110 Schlumberger Drive MD1
Sugar Land, TX 77478

EXAMINER

TUCKER, PHILIP C

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 12/05/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

622454

Applicant(s)

BAILEY ET AL

Examiner

P. TUCKER

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 10/3/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 9-12, 15-31 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 9-12, 15, 16, 26-28, 30, 31 is/are allowed.
- ☒ Claim(s) 17, 18, 20-25, 29 is/are rejected.
- ☒ Claim(s) 19 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892 _____ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 _____ Other _____

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 22 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 22, it is not clear what is meant by an "anionic fluid".

In claim 29, it is not clear what is meant by the term "reactive anionic".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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4. Claims 17, 21, 22 and 25 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Malchow (5807811).

Malchow teaches a water based drilling fluid which comprises a phosphonate according to the present invention and weighting agents, viscosifiers, filtration control agents and shale stabilizers (see example 3). The discovery by applicant of an inherent property of reducing cuttings accretion, and bit balling for the phosphonate additives does not distinguish over the prior art (In re Tomlinsin 150 USPQ 623). The present invention is thus anticipated by Malchow.

5. Claims 17, 18 and 20-25 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 4404219.

DE '219 teaches a water based clay composition which comprises a phosphonate according to the present invention, and may contain salts such as sodium silicate or sodium metaphosphate (see page 3, lines 16-19, and examples). The composition may be used as a drilling mud (page 2, lines 5-8). The discovery by applicant of an inherent property of reducing cuttings accretion and bit balling for the phosphonate additives does not distinguish over the prior art (In re Tomlinsin 150 USPQ 623). The present invention is thus anticipated by DE '219.

6. Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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7. Claims 9-12, 15, 16, 26-28, 30 and 31 are allowable over the art of record.

8. Applicants arguments have been considered but are not deemed fully persuasive.

Applicants amendments have overcome the rejection over the GB reference. Applicants arguments with respect to Malchow regarding the cuttings accretion and bit balling are not deemed persuasive. It is well established that a novel intended use does not impart patentability to an otherwise old or obvious composition (In re Pearson 181 USPQ 641, In re Zierden 162 USPQ 102). Also, the discovery by applicant of an inherent property of reducing cuttings accretion and bit balling for the phosphonate additives does not distinguish over the prior art (In re Tomlinsin 150 USPQ 623). A new rejection is presented in view of the DE '219 reference. It is noted that the formula used in claims 9, 15 and 17 is broad enough to encompass a phosphate, if R is attached by O. However, the claims are being interpreted in light of the teaching of the specification that the compounds are based on phosphonate chemistry, and not phosphate chemistry.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. is 703-872-9311.

PCT-2689
December 3, 2002


PHILIP C. TUCKER
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